

REMARKS

Applicants respectfully request reconsideration of the present application in view of the reasons that follow. Claims 22-34 were cancelled previously. Claims 18-21, 39-45, and 48-57 were requested to be cancelled in response to a restriction requirement. Claims 1-17, 35-38, 46, and 47 are pending in this application.

I. Rejection of Claims 1-17, 36-38, and 46 Under 35 U.S.C. § 103(a)

In section 1 of the Office Action, Claims 1-17, 36-38, and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,990,344 to Dolan *et al.* (Dolan) in view of US Patent Publication No. 2002/0019231 to Palenius *et al.* (Palenius). Though Applicants respectfully disagree, Applicants have amended Claim 1 to further distinguish over the cited references. Applicants respectfully submit that Dolan and Palenius, alone and in combination, fail to teach, suggest, or describe all of the elements of at least independent Claim 1.

Independent Claim 1, with emphasis added through underlining, recites:

providing information associated with a plurality of radio access means in a communications system to a network element of the communications system, said information based on a plurality of parameters associated with each of the plurality of radio access means for serving a mobile station, wherein a radio access means of the plurality of radio access means includes a plurality of cells, and further wherein the plurality of radio access means use different communication methods;

creating a prioritized ordering of the radio access means based on said information;

selecting a target radio access means of the plurality of radio access means based on the created prioritized ordering; and

sending a request to the mobile station to perform compressed mode measurements at the mobile station based on the selected target radio access means, said measurements for selecting a cell associated with the selected target radio access means.

On pages 2-3 of the Office Action, the Examiner states:

Regarding claim 1, Dolan teaches a method comprising: ... wherein the plurality of radio access means use different

communication methods (column 3, lines 1-41; first and second cellular networks);

ordering the radio access means based on said information (column 5, lines 38-56);

selecting a target radio access means of the plurality of radio access means based on the ordering (column 6, lines 11-20);

Applicants respectfully disagree.

Dolan describes a first cellular radio communication network 101 in a first country and a second cellular communication network 102 in a second country.” (Col. 3, lines 4-6).

Dolan further recites:

If the subscriber profile contains no IMSI identity (an alternative NO at step 501), the control unit 201 checks at step 502 whether there are any cells among the neighbouring cells of the serving cell which are incapable of acting as targets for handoff. In the exemplary first embodiment of the invention, neighbouring cells in the second cellular network 102 are incapable of acting as targets for handoff of a mobile station lacking an IMSI-identity.

The control unit 201 examines the neighbouring cell list field 302 of the cell record 301 associated with the serving cell to determine which neighbouring cell records 303 represent neighbouring cells of the serving cell. The control unit 201 examines the control domain field 305 of each neighbouring cell record 303 representing the neighbouring cells to determine whether the set of neighbouring cells includes any cells belonging to the second cellular network 102. If the set of neighbouring cells includes cells belonging to the second cellular network 102, the control unit 201 continues processing at step 503 where it prepares a measurement order list containing only control channels associated with neighbouring cells belonging to the first cellular network 101. In other words, when preparing the measurement order list, the control unit 201 omits all control channels associated with neighbouring cells which belong to the second cellular network 102, thereby being incapable of acting as targets for handoff of a mobile station lacking an IMSI identity.

(Col. 5, lines 30-56; underlining added). Thus, Dolan describes generation of a measurement order list which includes only cells capable of supporting a handoff of the mobile station.

Dolan does not teach “creating a prioritized ordering of the radio access means.” In the

exemplary embodiment described above, Dolan merely describes excluding the second cellular network because the cells are incapable of supporting a handoff of the mobile station.

Dolan further recites:

When the above described method is used for preparing a measurement order list for transmission to the first mobile station MS1 while it is operating in the first cell C1, the control unit 201 determines, at step 501, that the subscriber profile associated with the first mobile station MS1 contains no IMSI and, at step 502, that the set of neighbouring cells C2 C7 includes cells C5 C7 which are incapable of acting as target cells for handoff. Hence, the control unit 201 omits all control channels CC5 CC7 associated with the cells C5 C7 when preparing the measurement order list for transmission to the first mobile station MS1, i.e. the measurement order list contains only the control channels CC1 CC4.

After preparing the measurement order list, the first mobile switching center MSC1 orders the base station BS1 serving the first cell C1 to transmit the measurement order list in a TIA/EIA IS-136 Measurement Order message MO1 on the digital traffic channel DTC1 to the first mobile station MS1. The first mobile station MS1 performs measurements in accordance with the measurement order list and reports measurement results by transmitting TIA/EIA IS-136 Channel Quality messages CQ1 on the digital traffic channel DTC1 to the base station BS1 serving the first cell C1.

(Col. 5, line 65-col. 6, line 20; underlining added). Thus, again, Dolan describes generation of a measurement order list which includes only cells capable of supporting a handoff of the mobile station. Thus, Dolan fails to teach “creating a prioritized ordering of the radio access means.” Dolan also fails to teach “selecting a target radio access means of the plurality of radio access means based on the created prioritized ordering.” Dolan selects cells for inclusion in the measurement order list based on the cells capability of supporting a handoff of the mobile station. Dolan does not teach “selecting a target radio access means of the plurality of radio access means based on the created prioritized ordering.”

The Examiner agrees that Dolan “does not explicitly teach sending a request to the mobile station to perform compressed mode measurements at the mobile station based on the selected target radio access means.” (Pg. 3 Office Action). However, the Examiner states:

Palenius et al. discloses ... the access network commands the terminal to perform measurements for a selected measurement set of cells (page 6, paragraphs 50,55) which may include parameter settings for a compressed mode (performing compressed mode measurements at the mobile station) (page 6, paragraph 51).

(Pp. 3-4 Office Action; underlining added). The Examiner, however, does not indicate that Palenius teaches “sending a request to the mobile station to perform compressed mode measurements at the mobile station based on the selected target radio access means” (underlining added) as recited in Claim 1.

Palenius describes a first embodiment in which “the terminal receives a measurement command from the access network to which it is presently connected. In the command, the access network orders the terminal to perform measurements on at least one frequency band different from the band in which the terminal presently has connections.” (Para. [0050]). Relative to this embodiment Palenius further states that “the terminal can decide, e.g. in the above selection 32, on which cells in the current frequency band measurements are performed in case of an urgent handover.” (Para. [0058]). Thus, according to Palenius, the terminal (mobile station) receives a command and determines an ordering between cells not radio access means. Therefore, relative to this embodiment, Palenius fails to teach “creating a prioritized ordering of the radio access means,” “selecting a target radio access means of the plurality of radio access means based on the created prioritized ordering,” and “sending a request to the mobile station to perform compressed mode measurements at the mobile station based on the selected target radio access means” (underlining added) as recited in Claim 1.

Palenius also describes a second embodiment in which “the classification whether a handover is urgent is performed in a node in the access network, e.g. in an RNC.” (Para. [0061]). According to Palenius, in this embodiment, “suitable cells for measurements are selected by the access network in frequency bands in which the terminal presently has no connections ... [and] a further selection 66 is performed which number of cells shall be evaluated in the present frequency band of the terminal.” (Para. [0062]). Relative to this embodiment, Palenius also fails to teach “creating a prioritized ordering of the radio access means,” “selecting a target radio access means of the plurality of radio access means

based on the created prioritized ordering,” and “sending a request to the mobile station to perform compressed mode measurements at the mobile station based on the selected target radio access means” as recited in Claim 1.

Therefore, Dolan and Palenius fail to teach, suggest, or describe all of the elements of at least Claim 1. An obviousness rejection cannot be properly maintained where the references do not disclose all of the recited claim elements. For at least the foregoing reasons, Applicants respectfully request withdrawal of the rejection of Claims 1-17, 36-38, and 46.

II. Rejection of Claims 35 and 47 Under 35 U.S.C. § 103(a)

In section 2 of the Office Action, Claims 35 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dolan in view of Palenius and further in view of US Patent No. 5,655,217 to Lemson (Lemson). Applicants respectfully disagree. As discussed in Section I above, Dolan and Palenius fail to teach all of the elements of at least independent Claim 1 from which Claims 35 and 47 depend. Applicants respectfully submit that Lemson also fails to teach all of the elements of at least independent Claim 1.

Lemson describes “a system for allocating one or more ranges of transmission frequency to the communications network, in order to prevent the network from interfering with received signals of an incumbent radio system.” (Abstract). Lemson, however, fails to provide any teaching whatsoever related to “creating a prioritized ordering of the radio access means,” “selecting a target radio access means of the plurality of radio access means based on the created prioritized ordering,” and “sending a request to the mobile station to perform compressed mode measurements at the mobile station based on the selected target radio access means” as recited in Claim 1. As a result, Applicants respectfully request withdrawal of the rejection of Claim 35 and 47, which depend from Claim 1.

Applicants believe that the present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

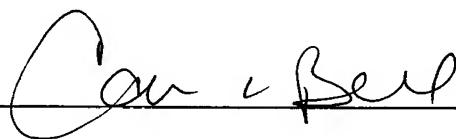
The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment,

to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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